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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,587

03/19/2004

Alan G. Bunte

37955AAA

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02/01/2005

John H. Sherman  
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EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/804,587	<b>Applicant(s)</b> BUNTE ET AL.	
	<b>Examiner</b> Ahshik Kim	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 3/19/04 (Initial filing of Application).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Claim of Benefit***

1. Acknowledged this Application claims the benefit under 35 USC § 119(e) and/or § 120  
5 as indicated in the Oath. The earliest filing date Applicant claims benefit is by US Serial No.  
07/849,771 filed on March 12, 1992. From the continuation data, Examiner can review the  
applications and/or patents for 08/461,605 (US 5,902,988) thereafter. Application and  
prosecution history before 08/461,605 are unavailable for review. During the examination of the  
instant application, Examiner may request Applicant to submit a copy of prosecution papers for  
10 some applications.

***Claim Objections***

2. Claim 19 is objected to because of the following informalities:

Re claim 19: period is missing at the end of the claim sentence.

15 Appropriate correction is required.

***Obviousness-Type Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in  
public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise  
20 extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple  
assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759  
F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA  
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163  
USPQ 644 (CCPA 1969).

25 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome  
an actual or provisional rejection based on a nonstatutory double patenting ground provided the  
conflicting application or patent is shown to be commonly owned with this application. See 37  
CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-64 are rejected under the judicially created doctrine of obviousness-type double  
5 patenting as being unpatentable over claims 1-20 of US Patent 5,821,523 to Bunte et al.  
(hereinafter '523 patent) and claims 1-20 of US Patent to Bunte et al. (US 6,330,975, hereinafter  
'975 patent)

Although the conflicting claims are not identical, it is the Examiner's view that they are  
not patentably distinct from each other.

10 In claim 35 of the instant application, the Applicant claims "An image capture system  
comprising: an optical reader subsystem in a first configuration providing a coded image and in a  
second configuration providing a photo image; and a controller subsystem coupled to the optical  
reader subsystem for controlling the operation of the optical reader subsystem to capture coded  
images and photo images."

15 In claim 1 of the instant application, the Applicant claims "An image capture system  
comprising: a portable reader subsystem operable to capture image information; said portable  
reader subsystem being operable in a first mode to read coded image information and operable in  
a second mode to capture photo image information; and a controller subsystem controlling the  
operation of the portable reader subsystem to capture coded image information and photo image  
20 information."

Claim 1 of '523 patent states "An image capture system comprising: an optical path; a  
photo-detector that captures via the optical path images that comprise coded images and non-  
coded, photo images; a controller, coupled to the photo-detector, selectively operable in a first

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mode and a second mode; and the controller, when operating in the first mode, attempts to decode images captured by the photo-detector, and, when operating in the second mode stores captured images without attempting decoding.

Granted that claim 35 and 1 of instant application are not a verbatim copy of claim 1 of '523 patent, they refer to an identical system. Examiner carefully and seriously considered whether inserted phrases "an optical reader subsystem" in claim 35 or "a portable reader subsystem" in claim 1 would in fact distinguish the instant application from '523 patent to warrant a new patent. However, reviewing claims 1-20 of '523 patent, functionalities such as photo image taking means and decoding means have to be embodied in a device. In many instances, it is the Examiner's observation that method claims often accompany the device/system claims in a parallel manner.

Other independent claims 53, 57 and 58 are an obvious variations of claim 1 and 35 of the instant application.

Claim 2 reciting first optical path and second optical path is recited in claim 2 of '975 patent.

First and second shutter referred along with first and second optical paths as recited in claim 8 is disclosed in claim 3 of '975 patent.

The image system further comprising a laser scanning device reading two-dimensional code as recited in claims 24 and 25 are disclosed in claim 7 of '975 patent.

Other elements are not distinguishable in that, for example, one element is referred as a "terminal", whereas in '975 patent it is referred as a "scanner" (claim 30 of the instant application and claim 7 of '975 patent).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

5

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

10 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-14, and 23-62 are rejected under 35 U.S.C. 102(b) as being anticipated by  
15 Sakaegi (US 6,040,856, hereinafter “Sakaegi”).

Re claims 1, 11, 12, 14, 23, 24, 26 27, 31, 33, 34, 35, 37, 38, 40-42, 45, 46, 49, 51-53, 55-  
58, and 62, Sakaegi teaches a portable terminal device functioning both photography and  
character recognition functions (see abstract; col. 1, lines 38-60). The terminal device is  
comprised of an image pickup device such as CCD (col. 2, lines 16+), a display means 13 and a  
20 console unit 14 for the users to enter operating instructions. As shown in figure 3, the  
photography mode or code recognition mode can be set by the users (col. 2, lines 39+). PC or  
other external device can also be used in setting the operation mode. Once the captured image is  
determined to be a bar code (or other optical characters), steps 419- 422 in figure 7A are  
performed, and the coded information would be recognized/decoded (col. 3, lines 58-64).

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Re claim 2, the captured image are processed differently based on whether it is considered an image data or character data. Image data could be stored in recording medium 8, and code data is decoded as shown in steps S419 – S422 in figure 7.

Re claims 3-10, 28, 29, 36, 47, and 59-61, conventional electronic camera often contains the features recited in the claims (i.e., aperture, shutter, zoom, and flash, etc.).

Re claims 13, 32, 48, and 54, the optical device can be connected to an external device via an external connector 12 (see figure 1; col. 2, lines 17+).

Re claim 25, readable code pattern includes JAN, code 39 and others which are two-dimensional bar code (col. 2, lines 49+).

Re claims 39 and 50, although Sakaegi is silent, the device inherently contains a buffer or memory area to transfer the captured image to other system components within the device or to the external system.

Re claims 43 and 44, the determination is made at step S404 whether captured image is a image data or barcode data (col. 3, lines 31+).

7. Claims 15-22, 63, and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinoshita (US 4,983,996, hereinafter “Kinoshita”).

Kinoshita discloses an image capture system comprising a camera subsystem 6, and a barcode reader subsystem 20 (col. 2, lines 26+). Barcode reader being adjustably connected, they can be oriented in different field of view than the image capturing subsystem (see figure 1).

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***Additional Remarks***

8. If Applicant were to argue that the cited references for 102 are invalid based on their effective dates and continuation information of the instant application, Examiner respectfully requests the applicant to list parent application(s) disclosing the subject matter recited

5 particularly in presented claims of the instant application. As indicated in paragraph 1 above, to the best of Examiner's search earliest patent/application is the effective date of US 5,821,523.

***Conclusion***

10 I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: XXXXX disclose two dimensional data reading and related methods. Applicant is respectfully suggested to carefully review these references.

15 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

20 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

25 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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Ahshik Kim  
Patent Examiner



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January 27, 2005